

## **REMARKS/ARGUMENTS**

Claims 90-95, 97-111, 113-120, 122-142 remain in the application for further prosecution. Claim 96 and 112 have been cancelled. Claims 90, 110, and 137 have been amended.

The Applicant very much appreciates the allowance of claims 106-109, 116-120, 122-127, 131-136, and 139-142

### **§ 112 Rejections**

Claims 137 and 138 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

The Examiner has indicated that these claims contain allowable subject, but that they should not positively claim the bone tissue. Applicant agrees with the Examiner. Positively claiming the bone tissue was not intended. Applicants have amended claim 137 to use the "for being" language, which still results in the concept of the dental implant being installed after the compaction tool creates the bore. However, it does so in a manner that avoids positively claiming the bone tissue. Applicants request that the Examiner enter this amendment to claim 137 as it places the case in a better condition for appeal. MPEP § 714.13.

### **§ 102 and § 103 Rejections**

Claims 90-95 and 97 are rejected under 35 U.S.C. § 102(b) as being anticipated by Balamuth (Re. 28,752).

Claims 98-100, 102, 103, 124-125, and 137-142 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,139,320 (Hahn).

Claims 101, 104, and 105 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,139,320 (Hahn) in view of U.S. Patent No. 4,832,683 (Idemoto et al).

Claims 110-115 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,139,320 (Hahn) in view of U.S. Patent No. 5,151,030 (Comeaux).

Claims 128-130 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,832,683 (Idemoto).

### **Independent Claim 90**

Independent claim 90 has been amended to include the limitations of allowable dependent claim 96. Because entry of this amendment for claim 90 simplifies the number of issues for appeal, Applicant respectfully requests that this amendment to claim 90 be entered. MPEP § 714.13.

### **Independent Claim 98**

Independent claim 98 has not been amended because this claim is clearly allowable over Hahn. To reject claim 98, the Examiner relies on Hahn's FIGS. 1 and 13. The Examiner alleges that the "osteotome or compaction tool (154)" meets the limitations of the osteotome tool that is used in the method of claim 98. Final Office Action, p. 4. The Applicant strongly disagrees with the Examiner.

The osteotome tool in claim 98 is to have an engaging surface to develop the elongated bore. That bore is "defined by bone tissue" and has a **"known length and width dimension as defined by said tool."** Hahn's tool is a chisel. It simply chips bone away. In fact, the specification lists other types of chisels that can also be used. ("a V-shaped or pyramidal chisel tip"; Col. 16, line 57)

As the Examiner is aware, claim 98 is not an apparatus claim. The Examiner cannot rely on an argument that Hahn's tool 154 could perhaps accomplish the method set forth in claim 98. Rather, the Examiner is required to show each and every element of this method claim. Accordingly, where is the teaching in Hahn about an elongated bore in bone tissue having "a known length and width dimension" as defined by the tool? The chisel tool 148 is not described as being able to create such a bore. FIG. 13 does a good job of illustrating what would be expected from the chisel tool 148 – it is chipping loose bone away in an unequal and non-uniform fashion. This could never be considered a bore having a "known length and width dimension," such as the well-defined bores shown throughout the figures of the present invention. In fact, although claim 98 states the bore is to be "defined by the bone tissue," the bore in FIG. 13 is partially defined by the tooth root 66.

Next, the Examiner has found one generic statement in Hahn about bone replacement materials and turned that generic statement into a teaching that a doctor would use bone replacement materials to fill the alleged "bore" of FIG. 13 along its entire length. But, there is no such teaching in Hahn. Nor is there even a hint that the alleged "bore" FIG. 13 is used with any type of bone replacement material. How can the Examiner be sure that the surgical procedure in FIG. 13 that produced the alleged "bore" was not a surgical procedure to reduce the bone height? How can the Examiner be sure that, assuming the bone replacement material were used, that it was not for filling only a part of the entire volume of the alleged "bore?" How can the Examiner be sure that if bone replacement material were used, that it did not fill the alleged "bore" to a point that was only 60% or 80% of the overall length of the alleged "bore?"

The point of these questions is straightforward – the Examiner has the burden of proof to set forth **actual** teachings in the cited prior art of each element of method claim 98. MPEP § 2143.03 The Applicant respectfully suggests that the Examiner has not done so.

### **Independent Claim 110**

Independent claim 110 has been amended to include the limitations of dependent claim 112. Because entry of this amendment for claim 110 simplifies the number of issues for appeal, Applicants respectfully request that this amendment to claim 110 be entered into the record. MPEP § 714.13.

While Applicant believes that former claim 110 was allowable over Hahn, without question, amended claim 110 is allowable over Hahn. It now requires that the “osteotome tool **simultaneously** engages said living bone substantially along an entire length of said bore.” The Examiner agrees that this limitation is not found in Hahn. Final Office Action, p. 5. Nevertheless, the Examiner alleges the skilled artisan would have simply redesigned the tool 154 in a way to engage the entire length of the bore “if upon necessity, a bore is formed large enough to accommodate a substantial portion of the tool.” *Id.* The Applicant is unsure what is meant by this statement and, thus, do not believe that this statement sets forth a sufficient basis for motivation to modify Hahn and arrive at the present invention. See MPEP §2143.01. Moreover, this statement fails to address the “simultaneously” language. Considering that Hahn teaches a chisel tool 154 that focuses energy at a defined point of contact to chip away a material, why would the skilled artisan modify the chisel 154 so as to simultaneously engage the entire length of the bore, thereby causing friction along the entire length and lessening its effectiveness as a chisel? The Applicant respectfully suggests that the Examiner is using hindsight to reject these

claims as the Applicant's own disclosure appears to be used as the "blueprint" for deriving the claim elements that the Examiner admits are lacking in Hahn.

### **Independent Claim 128**

Independent claim 128 has not been amended because this claim is clearly allowable over Idemato. Claim 128 requires "a cutting edge at a lowermost end and being generally perpendicular to said central axis," wherein "said central axis [is] extending between said lowermost end and said upper end." The Examiner alleges that Idemato's cutting edges 23, 24, and 25 meet these limitations. This is not true. First, Idemato's cutting edges 23, 24 and 25 are not at the lowermost end; rather, they are partially located away from the lowermost end towards the upper end. And second, the plane defining the cutting edges 23, 24, and 25 does not cross and, thus, cannot be perpendicular to the central axis. To the contrary, such a plane containing cutting edges 23, 24, and 25 is parallel to the central axis. Applicant notes that the "upper end" that defines the central axis is the part of the tool to be coupled to the driving mechanism ("coupling said upper end of said driving mechanism to said tool"), such that it is clear the central axis extends along the axial length of Idemato's tool. Applicant respectfully requests the Examiner to review FIGS. 4-6 of the present application and note that the cutting edges at the lowermost end are in a plane that is perpendicular to the central axis. This is substantially different from Idemato.

Not only does Idemoto fail to disclose the tool of claim 128, but the method of using the claimed tool is most assuredly not taught. Idemoto's tool 7 is never inserted into a bore in a manner whereby the central axis is generally perpendicular to bone. In fact, there is no teaching whatsoever in Idemoto of a bore. FIG. 6 surely does not illustrate a bore. The tool

7 is "spoon shaped" for chipping away and gathering material. Idemoto describes the tool 7 as one that is used for "cutting and separating biological tissue, particularly periosteum" ("periosteum" is the dense fibrous membrane covering the surface of bones and serving as an attachment for muscles and tendons). Col. 2, lines 14-15. As such, Idemoto's tool must be used at an acute angle relative to the bone to perform this scraping. See FIGS. 5-6. There is simply no teaching whatsoever in Idemoto of a tool engaging bone such that "said engaging occur[s] as said central axis is generally perpendicular to said living bone adjacent to said bore." The Examiner has admitted that Idemoto fails to teach this limitation. Final Office Action, p. 7. However, Idemoto's spoon-shaped tool requires an angled approach to the bone to perform its intended function and, thus, Idemoto's process could never be modified to arrive at the present intention without causing its structure to be rendered unsatisfactory for its intended purpose. See MPEP 2143.01.

In short, Idemoto fails to teach a bore. Idemoto fails to teach the cutting edges of the tool as set forth in claim 128. And, Idemoto fails to teach the "perpendicular" angle element of claim 128, which the Examiner admits, but then improperly modifies the teaching of Idemoto to arrive at this "perpendicular" angle element. A *prima facie* case of obviousness has not been set forth in rejecting claim 128.

## **Conclusion**

It is the Applicant's belief that all of the claims are now in condition for allowance and action towards that effect is respectfully requested.

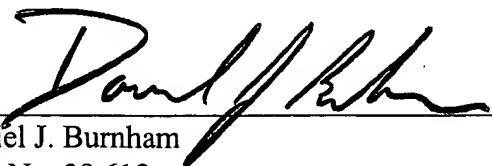
If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

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Reply to Final Office Action dated September 14, 2004

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the Examiner is requested to contact the undersigned attorney at the number indicated.

Respectfully submitted,

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